

REMARKS

Claims 1-8, 12, 14-18 and 27 are pending in the present application. In the above amendments, claims 1, 12, 17-18 and 27 have been amended, claim 11 has been cancelled, and new claims 28-32 have been added.

Applicant respectfully responds to this Office Action.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1-3, 5, 12, 14-15 and 27 as being unpatentable over U.S. Patent No. 5,077,791 in view of U.S. Patent No. 6,151,677 to Walter et al., and further in view of U.S. Patent No. 5,805,084 to Mannisto.

The rejection of claim 1 as being unpatentable over the Salihi patent in view of the Walter patent, and further in view of the Mannisto patent, is respectfully traversed. Claim 1, as amended, recites a method comprising determining whether a wireless handset is in a traditional mode, in an autosecure mode, or in a secure-only mode. If the handset is currently in the traditional mode, a secure call is originated if a key is held for a time period greater than the predetermined amount of time, and a clear call is originated if the key is held for a time period less than the predetermined amount of time. Alternatively, if the handset is currently in the autosecure mode, a secure call is originated if the key is held for a time period less than the predetermined amount of time, a confirmation request to originate a clear call is sent if the key is held for a time period greater than the predetermined amount of time, and a clear call is originated if the confirmation request is confirmed. Finally, if the handset is currently in the secure mode, a secure call is originated. The amendments to claim 1 are supported in the original specification at paragraphs [0013] and [0025], and by Figure 2. The Salihi, Walter and Mannisto patents fail to disclose three distinct modes for the handset: a traditional mode, an autosecure mode, and a secure-only mode. The Salihi patent shows only two modes in Figure 2 – a coded mode and an uncoded mode. Thus, the Salihi, Walter and Mannisto patents fail to disclose “determining whether a wireless handset is in a traditional mode, in an autosecure mode, or in a secure-only mode,” as recited in claim 1. Further, the Walter and Mannisto patents fail to disclose “if the handset is currently in the traditional mode, originating a secure call if the key is

PATENT

held for a time period greater than the predetermined amount of time, and originating a clear call if the key is held for a time period less than the predetermined amount of time; if the handset is currently in the autosecure mode, originating a secure call if the key is held for a time period less than the predetermined amount of time, sending a confirmation request to originate a clear call if the key is held for a time period greater than the predetermined amount of time, and originating a clear call if the confirmation request is confirmed; and if the handset is currently in the secure mode, originating a secure call” as recited in claim 1.

The examiner cites In re Venner, 120 U.S.P.Q. 192, to compare a manual switch to holding down a button for a certain period of time. The court in the Venner case held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. See, MPEP 2144.04. Applicant asserts that the Venner case is based on different facts. In the Venner case, manual operations of a user were merely replaced by an automated process. In contrast, as recited in claim 1, the manual operations of a user still remain. The user presses a button on the handset. However, as the Applicant has pointed out above, the response of the handset to the manual operations of the user is new and is not disclosed by the cited art.

Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1.

It is respectfully submitted that dependent claims 2-3 and 5 are at least allowable for the reasons given above in relation to independent claim 1.

Claims 12, 14-15 and 27 are apparatus claims having features defined by language similar to that of method claims 1-3 and 5. Accordingly, for the reasons recited above with respect to claims 1-3 and 5, claims 12, 14-15 and 27 define patentable advances over the Walter and Mannisto patents, and the rejections of claims 12, 14-15 and 27 should be withdrawn.

The Examiner rejected dependent claims 4 and 16 as being unpatentable over the Walter patent in view of the Mannisto patent, and further in view of U.S. Patent No. 5,845,205 to Alanara et al. Applicants assert that the Alanara patent fails to remedy the disclosure deficiencies of the Walter and Mannisto patents as described above with respect to claim 1. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections of claims 4 and 16.

PATENT

The Examiner rejected dependent claims 6-8 and 18 as being unpatentable over the Walter patent in view of the Mannisto patent, and further in view of U.S. Patent No. 6,442,406 to Harris et al. Applicant asserts that the Harris patent fails to remedy the disclosure deficiencies of the Walter and Mannisto patents as described above with respect to claim 1. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections of claims 6-8 and 18.

Claim 17 was not specifically rejected in the Office Action. Applicant asserts that claim 17, which depends on independent claim 27 recites patentable features over the cited prior art and should be allowed.

New Claims


Support for new claims 28-29 and 31-32 may be located in claims 3 and 4, and support for new claim 30 may be located in the original specification at paragraph [0053], and by Figure 2. Applicant respectfully asserts that new claims 28-32 recite patentable features over the cited prior art and should be allowed.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: November 25, 2008

By: 
Won Tae C. Kim, Reg. # 40,457
(858) 651 - 6295

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 658-5787
Facsimile: (858) 658-2502